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EXAMINER

GARTLAND, SCOTT D

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,151	Applicant(s) CONNELLY ET AL.	
	Examiner SCOTT D. GARTLAND	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☒ Claim(s) 7, 37, 44 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08-30-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This communication is in response to the application filed on November 23, 2003. Claims 1-64 are pending and presented for examination.

Priority

2. Applicant's claim for the benefit under 35 U.S.C. 119(e) to U.S. Provisional Application No. 60/469,496, filed on May 9, 2003, is acknowledged.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on August 30, 2007 was filed after the mailing date of the application on November 23, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

4. **Claims 7, 37, 44, and 55 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.** Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claims 7, 37, and 55 recite identical phrasing as that recited in parent claims 6, 36, and 54, respectively, except “**to therefore identify** relatively popular search queries”, which the Examiner understands to be explicit intended use. Since the intended use may be granted little or no patentable weight, claims 7, 37, and 55 do not further limit claims 6, 36, and 54, respectively.

Claim 44 recites “the system of claim 43, wherein the activation is accomplished by clicking on the search query link with a mouse controller.” The Examiner notes that claim 44 is directed to a system, and that the system itself does not change based on what user activity is performed on the system. As such, a user clicking a link with a mouse does not further limit the system of parent claims 31-32, 36, and 41-43. For examination purposes, the Examiner will interpret this to mean that a mouse is included in the system.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 45 and 63-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements of “receiving” and “selecting” are means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has searched Applicant's specification for a definition limiting the scope of the means for receiving, and notes that according to the specification, the means may be "via an on-line application" (paragraph 007), or via a web page and/or the internet (0036), which indicates that the “means for” may include software or a document (such as a web page), rather than a structural element or component. Furthermore, the means for selecting is described as being the Ad SWF (0082), which is identified as a type of file (0080). Since these elements are not defined as limited to structural components, the apparent limiting scope is outside the realm of a system.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material,

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or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim 63 recites a perceptible, changeable medium; however, the Examiner understands this to include virtually all forms or mediums of communication since Applicant, at specification paragraph 0074, indicates that this may include an audible medium, and paragraph 003 indicates that it also includes computers or billboards which would apparently be perceptible by sight. As such any communication, since it must be perceptible in order to be understood, appears encompassed; therefore the Examiner is uncertain as to the scope, or meets and bounds, of this claim.

Claim 64 depends from claim 63 and does not resolve the above issue, and therefore the Examiner is uncertain as to the scope, or meets and bounds, of claim 64 also.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 and 46-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is drawn to a method comprising steps of receiving, filtering and initiating display. Since the receiving may be performed audibly, the filtering performed in one's head, and the display initiated using pen and paper, no machine appears required, recited, or indicated. No transformation of matter is indicated or recited, either; therefore, since the method does not require a particular machine or transform matter, claim 1 is directed to nonstatutory subject matter.

Claims 2-10 depend from claim 1 and do not resolve this issue, and are therefore also directed to nonstatutory subject matter.

The Examiner suggests, as a remedy, reciting a significant step, such as the filtering step, as performed on a particular machine such as a computer programmed particularly for that function. The Examiner notes that of the current claim steps, receiving and initiating display appear to be insignificant extra-solution activity that may not impose a meaningful limit on the claim.

Claim 11 is drawn to a method comprising steps of receiving, filtering and facilitating display. Since the display is on a web page, a machine is required; however, the Examiner notes that facilitating display on a web page does not provide a meaningful limit on scope since it merely limits the display to the field of use to computer displays. No transformation of matter is indicated or recited, either; therefore, since the method does not require a particular machine or transform matter, claim 11 is directed to nonstatutory subject matter.

Claims 12-20 depend from claim 11 and do not resolve this issue, and are therefore also directed to nonstatutory subject matter.

The Examiner suggests, as a remedy, reciting a significant step, such as the filtering step, as performed on a particular machine such as a computer programmed particularly for that function.

Claim 46 is drawn to a method comprising steps of providing a feed of queries, providing advertising, and initiating display. Since the display is of a scrolling ticker, a machine is required; however, the Examiner notes that facilitating display of a scrolling ticker does not provide a meaningful limit on scope since it merely limits the display to the field of use to machines that would display a scrolling ticker. No transformation of matter is indicated or recited, either; therefore, since the method does not require a particular machine or transform matter, claim 46 is directed to nonstatutory subject matter.

Claims 47-61 depend from claim 46 and do not resolve this issue, and are therefore also directed to nonstatutory subject matter.

The Examiner suggests, as a remedy, reciting a significant step, such as a filtering, generating, solving, determining, or deciding step, as performed on a particular machine such as a computer programmed particularly for that function. The Examiner notes that of the current claim steps, providing a feed and advertising content as well as initiating display appear to be insignificant extra-solution activity, similar to sending and receiving, that may not impose a meaningful limit on the claim.

Claim 62 is directed to an advertisement. An advertisement is not considered to be one of a process, machine, article of manufacture, or composition of matter; therefore claim 62 is directed to nonstatutory subject matter.

Claim 63 is directed to a perceptible, changeable medium. The Examiner understands this to include virtually all forms or mediums of communication since Applicant, at specification paragraph 0074, indicates that this may include an audible medium, and paragraph 003 indicates that it also includes computers or billboards which would apparently be perceptible by sight. As such any communication, since it must be perceptible in order to be understood, appears encompassed. As a claim drawn to a medium, claim 63 is arguably within one of the statutory classes of a machine or article of manufacture; however, the claim is directed to the abstract idea

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of communication overall, only limited by filtered search queries, and as such is not directed to a practical application of that abstract idea. Furthermore, even if one could surmise that a search query were a practical application, claim 64 covers all practical applications of communicating a search query; therefore preempting all practical applications. Therefore claim 63 is directed to nonstatutory subject matter.

Claim 64 depends from claim 63 and does not resolve the above issue, and therefore claim 64 is also directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty

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defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 7. Claims 1-15, 17-18, 20-23, 25-27, 29-34, 36-41, 43-45, and 62-64 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Speiser et al. (U.S. Patent Application Publication No. 2004/0078214, hereafter Speiser).**

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

Claim 1: Speiser discloses a method of providing a display, the method comprising:

receiving search queries from multiple users (paragraph 0027; citation hereafter by number only);

filtering the search queries based on one or more filtering criteria (0056); and

initiating display of filtered search queries to viewers, the viewers remote from the users (0044, 0085-0086, Figs. 12A and B).

Claim 2: Speiser discloses the method of claim 1, wherein the filtering criteria include words (0056).

Claim 3: Speiser discloses the method of claim 1, wherein the search queries have associated demographic information and the filtering criteria include demographic criteria, the filtering including identifying queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc.).

Claim 4: Speiser discloses the method of claim 3, wherein the viewers have viewer demographics, the method further comprising selecting demographic criteria to match viewer demographics, the filtering including identifying queries having demographic information matching the viewer demographics, thereby initiating display of filtered search queries relevant to the viewers (0085; 0047).

Claim 5: Speiser discloses the method of claim 1, wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (0058, the Examiner understands terms matching the filter words to be discarded when they are prevented from being displayed and the determination moves to consider other terms).

Claim 6: Speiser discloses the method of claim 1, wherein the filtering criteria include number of times a search query is presented (0047; Fig. 4C, item 94).

Claim 7: Speiser discloses the method of claim 6, wherein the filtering criteria include number of times a search query is presented **to therefore identify** relatively popular search queries (0047; Fig. 4C, item 94).

Claim 8: Speiser discloses the method of claim 7, wherein initiating the display includes initiating display of filtered search queries to viewers at an event (0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 9: Speiser discloses the method of claim 6, wherein the filtering criteria include a certain website and a number of times a search query is presented, the filtering including identifying relatively popular search results received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 10: Speiser discloses the method of claim 6, wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including identifying relatively popular search queries received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 11: Speiser discloses a method of providing a display of information on a web page, the method comprising:

receiving search queries from multiple users (0027);

filtering the search queries based on filtering criteria (0056); and

facilitating display of said filtered search queries on the web page (0044, 0085-0086, Figs. 12A and B).

Claim 12: Speiser discloses the method of claim 11, wherein the display is an advertisement including display of said filtered search queries (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content; the Examiner notes that what data is displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 13: Speiser discloses the method of claim 12, wherein the advertisement is on behalf of an advertiser, the method further comprising receiving filtering criteria from the advertiser (0085-0086, Figs. 12A and B; the Examiner understands that the listings are on behalf of an advertiser since they have listed the item(s) for auction at the site, and that among the filter criteria are categories or specific sellers, such as Phone Cords, Prepaid Phone Cards, the Phones Store, Sharper Image, etc., the items are listed under).

Claim 14: Speiser discloses a method of claim 12, wherein the advertisement is for a product and the filtering criteria include an association between the product and search queries (0085-0086, Figs. 12A and B; the Examiner understands that the listings are for products, and the “Related” Items and Stores to indicate association).

Claim 15: Speiser discloses a method of claim 12, wherein the advertisement is for a product, the search queries have associated demographic information based on the users from which they are received and the filtering criteria include demographic criteria, the demographic criteria matching potential purchasers of the product (0085-0086, Figs. 12A and B, 0040, 0045, 0047, Fig. 4C; demographics indicated by country, language, etc.).

Claim 17: Speiser discloses the method of claim 11, wherein display of filtered search queries includes display of a filtered search query link, activation of which initiates display of search results corresponding to the filtered search query link (0085-0086, Figs. 12A and B).

Claim 18: Speiser discloses the method of claim 17, wherein initiating display of the filtered search queries includes facilitating display of an advertisement and wherein activation of the link further includes display of advertising content (0085-0086, Figs. 12A and B; the Examiner understands the items listed on the left of Fig.

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12A, such as the items at Fig. 12B, to be links, and activating the link directs to another list of ads, such as at the items shown in the middle of Fig. 12A).

Claim 20: Speiser discloses the method of claim 12, wherein the advertisement further includes a search tool bar (Fig. 12A, top left corner).

Claim 21: Speiser discloses a method for displaying data based on user input, the method comprising:

receiving user input from multiple users via an on-line application (0027);

automatically selecting received user input for display based on filtering criteria (0056); and

facilitating display of data based on the selected user input to users (0044, 0085-0086, Figs. 12A and B).

Claim 22: Speiser discloses the method of claim 21, wherein:

the user input is a query entered into a help application (0027; the Examiner understands searching to be a help application);

the selecting includes selecting received user input based on frequency of receipt (0047; Fig. 4C, item 94); and

the facilitating includes initiating display of a frequently received query (0047; Fig. 4C,) and a response to the frequently received query to the users (0085-0086, Figs. 12A and B).

Claim 23: Speiser discloses the method of claim 22, wherein the users are in communication via a network (0005).

Claim 25: Speiser discloses a client-server system for displaying data based on user input, the system comprising:

a first server communicatively coupled to the user interface, the first server **configured to** select received user input for display based on first filtering criteria (0030, 0044, 0056);

and visual display server configured to initiate display of data based on the selected user input (0044, 0085-0086, Figs. 12A and B).

Claim 26: Speiser discloses the system of claim 25, further comprising:

a second server communicatively coupled to the first server (0030), the second server **configured to** select received user input for display based on second filtering criteria (0040, 0047, 0085-0086, Figs. 12A and B).

Claim 27: Speiser discloses the system of claim 25, wherein the visual display server is further configured to initiate display of user input via a web page (0085-0086, Figs. 12A and B).

Claim 29: Speiser discloses the system of claim 25, wherein the user input is search queries (0027).

Claim 30: Speiser discloses the system of claim 25, wherein the display of data is display of an advertisement (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content).

Claim 31: Speiser discloses a system for display data based on user input, the system comprising:

one or more processors (0093-0094) configured to:

receive user input from multiple users via a network (0027);

select received user input for display based on one or more filtering criteria (0056); and

facilitate display of data based on the selected user input to viewers (0044, 0085-0086, Figs. 12A and B).

Claim 32: Speiser discloses the system of claim 31, wherein the user input is one or more search queries (0027).

Claim 33: Speiser discloses the system of claim 32, wherein the one or more filtering criteria include words (0056).

Claim 34: Speiser discloses the system of claim 32, wherein the search queries have associated demographic information and the one or more filtering criteria include demographic criteria, the one or more processors configured to identify queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc.).

Claim 36: Speiser discloses the system of claim 32, wherein the one or more filtering criteria include number of times a search query is received (0047; Fig. 4C, item 94).

Claim 37: Speiser discloses the system of claim 36, wherein the one or more filtering criteria include number of times a search query is received to therefore identify relatively popular search queries (0047; Fig. 4C, item 94).

Claim 38: Speiser discloses the system of claim 36, wherein the one or more processors are configured to facilitate display of selected search queries to viewers at an event (0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 39: Speiser discloses the system of claim 36, wherein the filtering criteria include a certain website and number of times a search query is received, the one or more processors configured to identify relatively popular search results received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 40: Speiser discloses the system of claim 36, wherein the one or more filtering criteria include demographic criteria and a number of times a search query is presented, the one or more processors configured to identify relatively popular search queries received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 41: Speiser discloses the system of claim 36, wherein the one or more processors are configured to facilitate display of selected search queries in an advertisement on a web site (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content; the Examiner notes that what data is displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 43: Speiser discloses the system of claim 42, wherein the one or more processors are configured to facilitate display of one or more selected search query

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links, activation of which initiates display of search results corresponding to the activated filtered search query link (0085-0086, Figs. 12A and B).

Claim 44: Speiser discloses the system of claim 43, wherein the activation is accomplished by clicking on the search query link with a mouse controller (0094).

Claim 45: Speiser discloses a system of displaying data based on user input, the system comprising:

means for receiving user input from multiple users via a network (0027, 0030, 0093-0094);

means for selecting received user input for display based on one or more filtering criteria (0056, 0030, 0093-0094); and

means for facilitating display of data based on the selected user input to viewers (0044, 0030, 0093-0094).

Claim 62: Speiser discloses an advertisement for display on a viewing device, comprising:

a portion for containing advertising content (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content); and

a portion for changeably displaying search queries that have been filtered in accordance with predetermined filter criteria (0047; Fig. 4C, items 94 and 96; 0085-

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0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content).

Claim 63: Speiser discloses a perceptible, changeable medium comprising: predetermined perceptible information (0085-0086, Figs. 12A and B); and perceptible, changeable search queries that have been filtered in accordance with filter criteria (0047; Fig. 4C, items 94 and 96; 0085-0086, Figs. 12A and B).

Claim 64: Speiser discloses the medium of claim 63, wherein the perceptible search queries change over time in accordance with predetermined change criteria (0040, 0047, 0056, 0085-0086).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 8. Claims 16, 19, 24, 28, 35, 42, and 46-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speiser.**

Claim 16: Speiser discloses the method of claim 12, wherein the advertisement includes a list of filtered search queries (0085-0086, Figs. 12A and B); however, Speiser does not explicitly disclose that the list is a scrolling list. The Examiner understands that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling list in the advertisement.

The rationale for combining in this manner is that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Claim 19: Speiser discloses the method of claim 11, but does not explicitly disclose wherein facilitating display of the filtered search queries includes initiating a Flash movie. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 24: Speiser discloses the method of claim 21, but does not explicitly disclose wherein the selecting includes disregarding input received from a first user where the first user has previously entered the search query or a similar search query. Speiser, however, teaches the number of searches (Fig. 4C, item 94) and that the number of results to popular searches according to category may be provided (0040). The Examiner understands that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to disregard input from a first user where the first user has previously entered the search query or a similar search query.

The rationale for combining in this manner is that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Claim 28: Speiser discloses the system of claim 25, but does not explicitly disclose wherein the visual display server is further configured to initiate display of user input via a Flash movie. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 35: Speiser discloses the system of claim 32, but does not explicitly disclose wherein the filtering criteria include search queries previously entered by users and the one or more processors are configured to discard previously entered search queries. Speiser, however, teaches the number of searches (Fig. 4C, item 94) and that the number of results to popular searches according to category may be provided (0040). The Examiner understands that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to disregard input from a first user where the first user has previously entered the search query or a similar search query.

The rationale for combining in this manner is that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

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Claim 42: Speiser discloses the system of claim 41, wherein the advertisement includes a list of selected search queries (0085-0086, Figs. 12A and B); however, Speiser does not explicitly disclose that the list is a scrolling list. The Examiner understands that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling list in the advertisement.

The rationale for combining in this manner is that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Claim 46: Speiser discloses a method of providing an advertisement, the method comprising:

providing a feed of search queries, the search queries received from users (0027);

providing advertising content (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content); and

initiating display of the advertisement (0044), the advertisement including search queries of the feed and the advertising content (0085-0086, Figs. 12A and B, 0047, Fig. 4C; the Examiner notes that what data is displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Speiser, however, does not explicitly disclose that the queries are in the form of a scrolling ticker of search queries. Speiser, however, teaches a list of selected search queries (0085-0086, Figs. 12A and B) and the Examiner understands that a scrolling ticker advertisement is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling ticker in the advertisement.

The rationale for combining in this manner is that a scrolling ticker advertisement is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 47: Speiser further discloses the method of claim 46, wherein the feed is an XML document (0029).

Claim 48: Speiser discloses the method of claim 46, but does not explicitly disclose wherein the feed is provided in near real time after receiving the search queries. Speiser, however, teaches tracking the date and time of day that a search query is entered (0045, Fig. 4A), and tracking the ending time of an auction to within 2 minutes (Fig. 12 A, upper right). The Examiner understands that the term “near real time” may refer to different periods or time delays depending on one’s perspective or reference; as such, the setting of process timing (or delays) so as to

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constitute near real time may change, and how close to actual real time one desires to be is limited primarily or only by processing speed and cost offsets. Therefore, the Examiner understands that providing a feed in near real time is both one of a limited number of predictable options available and a design choice.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to provide the feed of queries in near real time.

The rationale for combining in this manner is that providing a feed in near real time is both one of a limited number of predictable options available and a design choice.

Claim 49: Speiser further discloses the method of claim 46, wherein the search queries are filtered in accordance with one or more filtering criteria (0056).

Claim 50: Speiser further discloses the method of claim 49, wherein the filtering criteria include words (0056).

Claim 51: Speiser further discloses the method of claim 46, wherein the search queries have associated demographic information and the filtering criteria include demographic criteria, the filtering including identifying queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc.).

Claim 52: Speiser further discloses the method of claim 51, wherein the viewers have viewer demographics, the method further comprising selecting demographic criteria to match viewer demographics, the filtering including identifying queries having demographic information matching the viewer demographics, thereby initiating display of filtered search queries relevant to the viewers (0085; 0047).

Claim 53: Speiser further discloses the method of claim 46, wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (0058, the Examiner understands terms matching the filter words to be discarded when they are prevented from being displayed and the determination moves to consider other terms).

Claim 54: Speiser further discloses the method of claim 46, wherein the filtering criteria include number of times a search query is presented (0047; Fig. 4C, item 94).

Claim 55: Speiser further discloses the method of claim 54, wherein the filtering criteria include number of times a search query is presented to therefore identify relatively popular queries (0047; Fig. 4C, item 94).

Claim 56: Speiser further discloses the method of claim 55, wherein initiating the display includes initiating display of filtered search queries to viewers at an event

(0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 57: Speiser further discloses the method of claim 54, wherein the filtering criteria include a certain website and a number of times a search query is presented, the filtering including identifying relatively popular search results received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 58: Speiser further discloses the method of claim 54, wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including identifying relatively popular search queries received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 59: Speiser discloses the method of claim 46, but does not explicitly disclose wherein initiating the display includes incorporating the search queries into a Flash movie clip. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 60: Speiser further discloses the method of claim 46, wherein the scrolling ticker of search queries includes one or more links associated with one or more search queries, respectively, wherein each link is to search results corresponding to the associated search query (0085-0086, Figs. 12A and B).

Claim 61: Speiser further discloses the method of claim 46, wherein initiating display of the advertisement includes initiating inclusion of a search window for receiving a new search query in the advertisement (Fig. 12A, top left corner).

9. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive

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inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements" and where the court interpreted the claimed phrase "said ferrule-forming member being crimpable onto said shield means" and held that the shield means was not a positive element of the claim since "[t]here is no positive inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements.... "[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.").

The Examiner has analyzed the claim language and phrasing as indicated by the **bold** sections or words above, and determined that the phrasing following the **bolded** word(s) is not required due to the terminology being optional or intended use or expected results, in conformity with MPEP § 2111.04.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is 571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number

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for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. G./
Examiner, Art Unit 3622

/John Van Bramer/
John Van Bramer
Examiner, Art Unit 3622